

REMARKS

Rejection Pursuant to Section 103

Claims 1, 5, 6, 8-10, 12-14, 16, 18-21, 24-30, 33, 35-37, 39 and 41-43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,311,293 to MacFarlane in view of U.S. Patent No. 4,561,850 to Fabbri et al. Applicant traverses this rejection for the reason that MacFarlane teaches away from Fabbri et al. and, accordingly, may not be combined with Fabbri et al.

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re ICON Health and Fitness Inc.*, 83 USPQ2d 1746 (Fed. Cir. 2007)(quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)); see also *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40 (2007)(explaining that when the prior art teaches away from a combination, that combination is more likely to be nonobvious).

MacFarlane discussed a method and instruments for use in a color selection system in which a person's skin color was the exclusive determinative factor for color compatibility. The Examiner also now agrees that “the MacFarlane invention is disclosed as being based only on skin color ...”. See Office Action at 7. However, the Examiner's concession was qualified in that the Examiner also stated that MacFarlane “does not teach that other physical characteristics could not be incorporated as secondary considerations.” *Id.* Applicant respectfully disagrees.

The relevant dictionary definition of the term “exclusive” is “*excluding or having the power to exclude*”. See Attachment A. Likewise, the relevant dictionary definition of the term

"only" is "alone in class". Id. Therefore, by definition, MacFarlane's use of skin as the exclusive determinative factor for color compatibility means that MacFarlane does, in fact, exclude the use of other physical characteristics as secondary considerations.

Applicant also respectfully reiterates and incorporates herein by reference its prior arguments that MacFarlane and Fabbri et al. would render a dysfunctional invention

In view of the above, it would be improper to combine MacFarlane (which teaches away from the use of multiple characteristics) with Fabbri et al. (which the Examiner has relied upon as teaching the use of multiple characteristics). Indeed, a person of ordinary skill upon reading MacFarlane would clearly be discouraged from following the path set out in MacFarlane. Therefore, Applicant respectfully submits that it has rebutted the Examiner's claim to a *prima facie* case of obviousness.

In view of these remarks, Applicant submits that claims 1, 5, 6, 8-10, 12-14, 16, 18-21, 24-30, 33, 35-37, 39 and 41-43 are all properly allowable of the prior art. Applicant also specifically asserts that all of the above identified dependent claims are allowable as they depend from an allowable independent claim. Applicant, however, reserves the right to submit additional arguments, or address specific arguments concerning any dependent claims, in the event the Examiner again rejects one or more of them.

Rejection Pursuant to Section 101

All claims have been rejected as being drawn to non-statutory subject matter.

The independent claims have now been amended to recite various forms of a tangible data set that is generated as a result of the claims method(s). Therefore, Applicant requests that the rejection under Section 101 now be withdrawn.

Rejection Pursuant to Section 102

Claims 1, 5-7, 10, 16-17, 20, 22-23, 26-27, 32-34, 37, 39-40 and 43 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,478,238 to Gourtou. In Gourtou, video camera 14 is disclosed as being used solely in connection with measuring skin color. See Gourtou, Col. 6, Line 56 – 57. As such, the video camera is used to capture an image that includes data for only one physical characteristic (i.e., skin color).

In contrast to Gourtou, the independent claims have been amended to indicate that the input device may capture an image of the individual comprising data of at least two physical characteristics for the individual. For example, claim 7 is directed to a digital camera that may capture data relating to an individual's eye color, hair color and skin color in a single image.

Therefore, Applicant submits that the claims as amended are allowable of Gourtou. Applicant also specifically asserts that all of the above identified dependent claims are allowable as they depend from an allowable independent claim. Applicant, however, reserves the right to submit additional arguments, or address specific arguments concerning any dependent claims, in the event the Examiner again rejects the one or more of them.

Finally, Applicant submits that a further search of the art should not be necessary in view of the instant amendment since the amendment merely narrowed the scope of the claims.

Applicant submits that the application is now in proper form for allowance. Such action is respectfully requested.

Dated: November 29, 2007

Respectfully submitted,

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